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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/289,957	04/13/1999	JOHN S. HENDRICKS	026880.00024	9303
4372	7590	11/18/2008		
ARENT FOX LLP 1050 CONNECTICUT AVENUE, N.W. SUITE 400 WASHINGTON, DC 20036			EXAMINER WINTER, JOHN M	
			ART UNIT 3685	PAPER NUMBER
			NOTIFICATION DATE 11/18/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No. 09/289,957	Applicant(s) HENDRICKS ET AL.	
	Examiner JOHN M. WINTER	Art Unit 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2, 4- 41, 43-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2, 4- 41, 43-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. The Applicants amendment filed on September 28, 2007 is acknowledged, Claims 2, 4- 41, 43-58 remain pending.

Response to Arguments

The Applicant's arguments filed on June 28 2008 have been fully considered. Applicant's arguments, with respect to lack of establishing a valid priority date have been fully considered and are persuasive.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 2, 4-41 and 43-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartrick et al. (US Patent 5,532,920) in view of Wolfe (US Patent 4,796,220) .

4. As per claim 2,

Hartrick et al. ('920) discloses an apparatus that provides electronic books to a subscriber, comprising;

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a processor that communicates with an electronic book ordering site, the processor supplying an electronic book selection and a processor identification; (Column 12, lines 20-33)

- (a) a transmitter, coupled to the processor, that sends the electronic book selection and the processor identification to the ordering site (Figure 8A);
a receiver module that receives a data signal and a local authorization code, wherein the data signal comprises an encrypted electronic book selection and wherein the local authorization code allows the data signal to be decrypted for viewing;(Figure 9A)
- (b) a memory coupled to the receiver module, the memory storing the received authorization code until needed for decrypting the data signal. (Column 6, lines 61-67)
a viewer capable of receiving data, wherein the viewer, comprises: a decryptor that decrypts the data signal, a display that displays pages of the electronic book, a book memory that stores the electronic book, and a control module that controls viewing of the electronic book (Column 7, lines 20-47)

Examiner notes -- it has been held that the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art- if the prior art has the capability to so perform (MPEP 2114 and *Ex parte Masham*, 2 USPQ2d 1647 (1987)). Similarly, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2214; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997), many of the feature of the claimed invention (i.e. that

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sends the electronic book selection and the processor identification to the ordering site” etc
.. ate directed towards intended usage of the apparatus.))

Hartrick et al. ('920) does not explicitly disclose “wherein the local authorization code includes an expiration, wherein upon occurrence of the expiration, the selected electronic book cannot be decrypted using the local authorization code” Wolfe ('220) ('515) discloses “wherein the local authorization code includes an expiration, wherein upon occurrence of the expiration, the selected electronic book cannot be decrypted using the local authorization code”

5. . (Column 7, lines 24-56) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Hartrick et al method with the Wolfe method in order to securely distribute software

6. As per claim 4,

Hartrick et al. ('920) discloses The apparatus of claim 2
wherein the library unit further comprises an external interface to an external receiver, the external receiver receiving the data signal, the external interface transmitting the data signal to the library unit.(Figure 2 – element 92 network adapter)

7. As per claim 5-8

Hartrick et al. ('920) discloses The apparatus of claim 4
wherein the external receiver is a modem.(Column 6, lines 51-54)

Examiner notes that the usage of any type of receiver to input data is well known in the art of data transfer.

8. As per claim 9

Hartrick et al. ('920) discloses The apparatus of claim 2 wherein the receiver module, the processor, the transmitter and the memory are contained in a set top terminal operably connected to a television, and wherein the receiver module receives broadcast television program signals, the data signal multiplexed with the television program signals, the apparatus further comprising a demultiplexer to demultiplex the data signal and the television program signals. (Column 7, lines 19-24; Examiner notes - it has been held that the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art- if the prior art has the capability to so perform (MPEP 2114 and *Ex parte Masham*, 2 USPQ2d 1647 (1987)). Similarly, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2214; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)).)

9. As per claims 10-12

Hartrick et al. ('920) discloses the apparatus of claim 2 Official Notice is taken that "the memory and the processor are contained on a smart card incorporated into a digital television, and wherein the receiver module receives broadcast television program signals," is common and well known in prior art in reference to data transfer protocols. It would have been obvious to one having ordinary skill in the art at the

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time the invention was made to utilize a smart card in order to control access rights and usage of the broadcast content .

10. As per claim 13,

Hartrick et al. ('920) discloses The apparatus of claim 2 wherein the receiver module, the processor, the transmitter, and the memory are incorporated into a personal computer. (Figure 1, column 6, lines 44-54)

11. As per claim 14,

Hartrick et al. ('920) discloses The apparatus of claim 13 wherein the personal computer further comprises a connector that couples the personal computer to a digital television, the digit television comprising a second receiver that receives the digital broadcast television program signals and the data signal, and wherein the receiver module receives the local authorization code and the data signal and the personal computer sends the data signal and the local authorization code to decrypt the data signal. (Figure 1, column 6, lines 44-54 Examiner notes -- it has been held that the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art- if the prior art has the capability to so perform (MPEP 2114 and *Ex parte Masham*, 2 USPQ2d 1647 (1987)). Similarly, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2214; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir.

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1997)).) Furthermore the mere duplication of a claim element (i.e. second receiver) does not merit patentability)

12. As per claims 15-16,

Hartrick et al. ('920) discloses The apparatus of claim 13

Official Notice is taken that “wherein the connector is one of a

radio frequency connector, an infra red connector and a wired connector, wherein the wired

connector comprises RS-232 connections and an RS-232 cable.” is common and well

known in prior art in reference to data transfer protocols. It would have been obvious to one

having ordinary skill in the art at the time the invention was made to utilize an industry

standard interface such as a RF connector or wired connector because interfaces are

recognized as an industry standard and do not require special implementation.

13. Claims 17 – 41 and 43- 58 are not patentably distinct from the above rejected claims and are rejected for at least the same reasons.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN M. WINTER whose telephone number is (571)272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMW

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685